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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,199	01/20/2004	Kotaro Watanabe	Q79452	7754
23373	7590	11/28/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHU, JOHN S Y	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,199

Applicant(s)

WATANABE ET AL

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the response of September 15, 2006.

1. The reference to KAWAMURA et al is **removed** from the rejection below based on the common ownership as stated by applicant's attorney in the remarks of September 15, 2006.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAKE et al in view of KITSON et al (6,858,359 B2).

The claimed invention has been recited above and is included by reference.

MIYAKE et al has been discussed in previous paragraph 2 for the limitations related to claims 1-6, 9 and 11. MIYAKE et al lacks the claimed limitations as recited in dependent claims 7,8, 10, 12 and 13.

KITSON et al '359 discloses in the same field of invention of planographic printing plates, a thermally sensitive, multilayer imageable element comprising a substrate, an underlayer over said substrate and a top layer over said underlayer. Applicants are directed to column 9, lines 1-8 for the disclosure of suitable novolak resins used in the imageable top layer. The components used to make the novolak resin include phenol, cresol, m-cresol, p-cresol, t-butyl phenol and pyrogallol as phenolic components, which can be condensed with formaldehyde. The disclosure provides to the skilled artisan a teaching that these components are functionally

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equivalent to one another with respect to use in a novolak resin for imageable top layers in planographic printing plates.

Applicants are further directed to column 7, lines 6-14 wherein the material comprises a photothermal conversion agent, which is preferably used in the underlayer as recited in lines 10-13. Examples 1-6 in column 19, lines 10-56 exemplify the use of an IR Dye A in the underlayer as see in line 18. Seeing this disclosure, one of ordinary skill is taught and motivated to use photothermal converting agents in any of the layers of a lithographic printing plate.

Oniums salts are disclosed in column 9, lines 43 – column 10, line 14 wherein the onium salts are used as additives in the image recording top layer. It would have been *prima facie* obvious to one of ordinary skill in the art of lithographic printing plates to add an onium salt as an additive ingredient to the imaging layer as suggested by MIYAKE et al with the reasonable expectation of same or similar results as taught in MIYAKE et al.

Use of a blend of novolak resins singly or in combination is disclosed in column 7, line 65 – column 8, line 4 of MIYAKE et al. Here again the skilled artisan is taught to use more than one novolak resin meeting the recited scope in claim 8, such that a 50/50 mix easily renders the claim *prima facie* obvious.

It would have been *prima facie* obvious to one of ordinary skill in the art of lithographic printing plates to add a photothermal conversion agent into the underlayer of MIYAKE et al as taught by KITSON et al as well as use an additive onium salt and have a novolak blend in the top layer with reasonable expectation of same or similar results as recited in MIYAKE et al. Further the artisan would expect the top layer to have minimal ablation of the layer upon exposure to an infrared laser as taught in KITSON et al, column 7, lines 9-12.

It would have been *prima facie* obvious to one of ordinary skill in the art of lithographic printing plates to use either of the underlayers of KITSON et al or MIYAKE et al and reasonably expect same or similar results with respect to the lithographic properties of MIYAKE et al.

The arguments by applicant have been carefully considered however the rejection is repeated for the following reasons:

1) In KITSON et al the m-cresol content of Example 3 and 6 is at least 10 % by mole and the molecular weight of some of the suitable novolak resin as seen in the Glossary (column 17, line 35 – column 18, line 35) are under 10,000, see Examples 2,3 and 6 of Table 1 in column 19.

2) The multilayer structure is addressed in the discussion of KITSON et al above and is included by reference.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

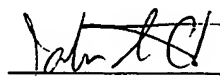
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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526

The fax phone number for the USPTO is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu

Primary Examiner, Group 1700

J.Chu

November 27, 2006